

REMARKS

Claims 1-44, 46-78 and 80-90 are pending in this application. Claims 1, 30, 46, 47 and 56 are amended. Claims 45 and 79 have been canceled. Claims 80-90 are new. No new matter is introduced. Reconsideration and prompt allowance of the claims are respectfully requested.

The Office Action rejects claims 1-4, 15, 17-18, 30-34, 48-50, 56-57, 64, 68, 71-74, and 78 under 35 U.S.C. §102(e) as being anticipated by DeRose et al., U.S. Patent No. 5,557,722 (hereafter, *DeRose*). The Office Action rejects claims 16, 19-25, 45-47, 67, 75 and 79 under 35 U.S.C. §103(a) as being unpatentable over *DeRose*. The Office Action rejects claims 5-6, 35-38, 43-44, and 58-59 under 35 U.S.C. §103(a) as being unpatentable over *DeRose* and in view of Reed et al., U.S. Patent No. 5,241,671 (hereafter, *Reed*). The Office Action rejects claims 7-9, 13-14, 26-27, 39-42, 51-52, 60-63, 65-66, and 76-77 under 35 U.S.C. §103(a) as being unpatentable over *DeRose* and in view of Bernstein et al., U.S. Patent No. 5,204,947 (hereafter, *Bernstein*). The Office Action rejects claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over *DeRose* and in view of *Bernstein* and in further view of Saigh, U.S. Patent No. 5,734,891 (hereafter, *Saigh*). The Office Action rejects claims 28-29, 53-55, and 69-70 under 35 U.S.C. §103(a) as being unpatentable over *DeRose* and in view *Saigh*.

Applicant traverses these rejections.

Applicant submits that *DeRose* does not expressly or inherently describe each and every element of the claimed invention.

DeRose does not disclose or suggest, at least, “links between the components of the digital data, wherein when the links are activated, a first component is connected to a second component and wherein a link between the first and the second components is a two-way link” (emphasis added), as recited, among other features, in independent claim 1 (as presented). Claim 1, as amended, includes the features of dependent claim 79 (now canceled). These features of claim 79 are also incorporated into independent claim 56 which recites, among other features, “displaying a second component linked to the first component, wherein an electronic link between the first and the second components is a two-way electronic link” (emphasis added).

The Office Action at page 10 states that “DeRose does not explicitly show that the link between two components is a two way link.” However, Office Action states at page 11 that “[i]t would have been obvious to have used the teaching of the cross-reference link from DeRose to have created a two way link between two components of the electronic book so that the user

would have easily and directly traversed the book from one component to the other and vice versa.” Without pointing to any reference disclosing a “two-way” link, the Office Action merely states some of the advantages of providing a “two-way” link, as claimed. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See, e.g.*, MPEP § 2143.03 and § 706.02 (j). Since the Office Action does not provide any reference disclosing a “two-way” link, Applicant submits that independent claims 1 and 56 (as presented) are in condition for allowance over *DeRose* for at least these reasons.

Moreover, *Reed*, *Bernstein* and *Saigh* fail to overcome the deficiencies of *DeRose* described above. For example, none of the applied references, applied separately or in combination, disclose or suggest a link between the first and the second components is a two-way link, as claimed.

Applicant submits that independent claims 1 and 56 are in condition for allowance over the applied art for at least these reasons.

With respect to independent claim 30, *DeRose* does not disclose or suggest a method for linking electronic files to electronic books which includes “providing a menu, wherein the menu includes a show links menu, and wherein the show links menu displays all available electronic links associated with a selected location in the first electronic link,” as recited, among other features, in independent claim 30, as presented. Claim 30, as amended, includes the features of dependent claim 45 (now canceled).

The Office Action at page 9 states that *DeRose* does not explicitly teach that the links are selected through the use of a menu. Again, without providing a reference disclosing the claimed “show links menu,” the Office Action states that it would have been obvious and desirable to have a menu to show available links. Applicant disagrees. As above, the MPEP requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143.03 and § 706.02 (j).

Since the applied references including *DeRose*, *Reed*, *Bernstein* and *Saigh* fail to disclose or suggest at least a show links menu that displays all available electronic links associated with a selected location in the first electronic link, as claimed, Applicants submit that independent claim 30 (as presented) is in condition for allowance over the applied art.

In addition, claims such as new independent claim 80 and dependent claims 19-21, 47 and 87 are directed to features related to a "links menu." Therefore, claims 19-21, 47, 80 and 87 are in condition for allowance for these additional reasons.

Applicant submits that the applied references fail to disclose or suggest:

receiving a selection of content associated with an electronic book from a user; receiving a selection of additional content from the user; and in response to a request from the user, creating a link between the selected content associated with the electronic book and the selected additional content,

as recited, among other features, in new independent claim 86. Support for these features can be found in the specification at page 4, lines 21-27 and page 50, lines 4-22, for example. Applicant submits that claim 86 is in condition for allowance over the applied art.

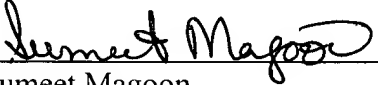
Claims 2-29 depend from independent claim 1, claims 31-44 and claims 46-55 depend from independent claim 30, claims 57-78 depend from independent claim 56, new claims 81-85 depend from new independent claim 80 and new claims 87-90 depend from new independent claim 86. Therefore, claims 2-29, 31-44, 46-55, 57-78, 81-85 and 87-90 are allowable for at least the reasons stated above.

In view of the above remarks, Applicant respectfully submits that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

Date: **February 23, 2004**


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